

REMARKS

Claims 1-63 were pending in the Application prior to the outstanding Office Action. With this Amendment, claims 1-63 remain in the case.

Objections to Claims 2, 13 and 63; 12 and 36

The Examiner objects to **claims 2, 13 and 63; 12 and 36** on the basis of various informalities.

Claims 2, 13 and 63

The Examiner objects that **claims 2, 13 and 63** on the basis of various informalities, which Applicants have confirmed were mistakenly introduced by retyping the originally presented claims. The informalities have been corrected and the claims labeled “original”, as they now conform to the claims presented when the national phase was entered using PCT publication no. WO 00/068824, published November 16, 2000.

Therefore, the objections to claims 2, 13 and 63 should be withdrawn.

Claims 12 and 36

The Examiner objects that **claims 12 and 36** due to lack of the article “a” before “communications”. This has been corrected by amendment.

Therefore, the objections to claims 12 and 36 should be withdrawn.

Rejection Under 35 U.S.C. § 103(a) of Claims 1-4, 6-11, 14, 16, 18-23, 25-28, 30-35, 38, 40, 42-47, 49-60 and 62

The Examiner rejects **claims 1-4, 6-11, 14, 16, 18-23, 25-28, 30-35, 38, 40, 42-47, 49-60 and 62** under 35 U.S.C. § 103(a) as unpatentable over Prithviraj (US 5,987,513) in view of Lonnroth (US 6,826,597).

Claim 1

Claim 1 includes the limitations:

accessing a page containing network management information stored on a palm-sized computer;

indicating a network management function;

connecting to a synchronization server;

transmitting the indicated network management function to the synchronization server; and

receiving updated network management information, responsive to the indicated network management function.

These limitations are not found in Prithviraj in view of Lonnroth.

The Examiner argues that temporarily caching a page on a client computer prior to display causes it to be stored on the computer, referring to Prithviraj figure 5 reference 540. The meaning of “store” is not infinitely malleable; the specification and common usage are touchstones for understanding “store”. For instance, pages 18, 21 and 37 of the specification clearly distinguish between pages stored locally on the handheld device and those stored on a remote server. The limitation “stored on the palm-sized computer” would be meaningless if loading a page in memory before displaying it were enough to satisfy the limitation. Prithviraj uses “store” in the same sense as this claim and teaches away from using a page locally stored away from the server, in figure 5:



For these reasons, the temporary caching of pages loaded from a server onto a desktop computer, per Prithviraj figure 5 reference 540, does not read on first element of claim 1. Therefore, claim 1 should be allowable over Prithviraj in view of Lonnroth.

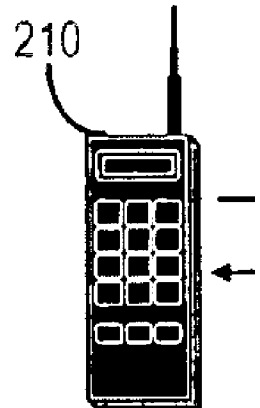
The second element of this claim requires indicating a network management function before initiating synchronization with a server. In Prithviraj, the computer is interacting with a conventional network / web server when the network management function is indicated. For this additional reason, claim 1 should be allowable over Prithviraj in view of Lonnroth.

The third and fourth elements of this claim refer to a synchronization server. The Examiner cites a different component of Prithviraj's disclosure than in the last office action: “figure 5 #560, NMS 101 can be considered a synchronization server because it synchronizes the network topology display according to network conditions.” Simply “updating data” is not quite the same as “synchronization.” Prithviraj teaches only updating:

UPDATE THE TEMPLATES BEFORE DISPLAY**560**

There is no notion in Prithviraj of synchronization; the stem “synchron*” does not appear in a string search of the reference. Conventional meaning is given to a “synch server” throughout the specification of this application, which needs to be given weight when considering patentability. For these additional reasons, claim 1 should be allowable over Prithviraj in view of Lonnroth.

The Examiner goes on to interpret Lonnroth as accessing an HTTP server (110) using a browser on a palm-sized computer (210). The palm-sized device in Lonnroth is a cell phone depicted with a limited display. Reference 210 is illustrated and referred to as a “phone”. The server access by phone 210 is via WAP, which is not the same HTML/HTTP protocol used in Prithviraj. Lonnroth uses an intermediate server to convert XML data using an XSL spreadsheet into wireless markup language (WML) so that the cell phone does not need an HTML browser. The cell phone is not presented as capable of storing a network management page prior to connecting to a synchronization server or as capable of interacting with a synchronization server. As Lonnroth does not add the claimed elements to Prithviraj, neither of the references include claimed elements and neither can the combination. This is yet another reason that claim 1 should be allowable over Prithviraj in view of Lonnroth.



On page 4 of the office action, the Examiner makes two assertions of what was well known in the art at various times. We challenge the well-known assertions and request evidentiary support as required by MPEP § 2144.03. First, Lonnroth does not show using a palm-sized computer to access an HTTP server, as explained above. Therefore, it is not evidence. Second, the Examiner has acquiesced in Applicants' position that Xerox's TAB computer is another example of a palm-sized computer that was incapable of accessing an HTTP server. Third, while form factor is an interesting aspect of a computer, so are computing power and battery life. Without knowing more, it would be premature to agree that portability and small size would be universal motivators. Patent No. 5,727,159, col. 1, lines 36-40, is not evidence of the proposed well-known fact, as the passage cited emphasizes the penalty paid for small size and portability. (The fantastic prophetic claims of extending battery life from 8 minutes to “approaching 2 weeks”, at col. 7, lines 39-43, are implausible and premised on the

palm-sized computer not interacting with an HTTP server. *Id.*) The ‘159 patent is further evidence that it was not well-known to have a palm-sized computer access an HTTP server.

We pointed out in our last response the legal requirements for combining references. *Response*, at 11-13 (mailed Aug. 8, 2005), which we incorporate herein by reference. Instead of responding, the Examiner declared the issue moot. We hereby reassert the issue, because the basis for combining Prithviraj with Lonnroth in this action falls short for the same reasons as did the Examiner’s basis in the April 7, 2005 office action.

For these many reasons, claim 1 should be allowable.

Claim 25

Claim 25 applies a method to a *scope of network inventory information*, locally stored on a palm sized computer, in terms similar to claim 1:

accessing a page containing network inventory scope choices stored on a palm-sized computer;

indicating a scope of network inventory information;

connecting to a synchronization server;

transmitting the indicated scope of network inventory information to the synchronization server; and

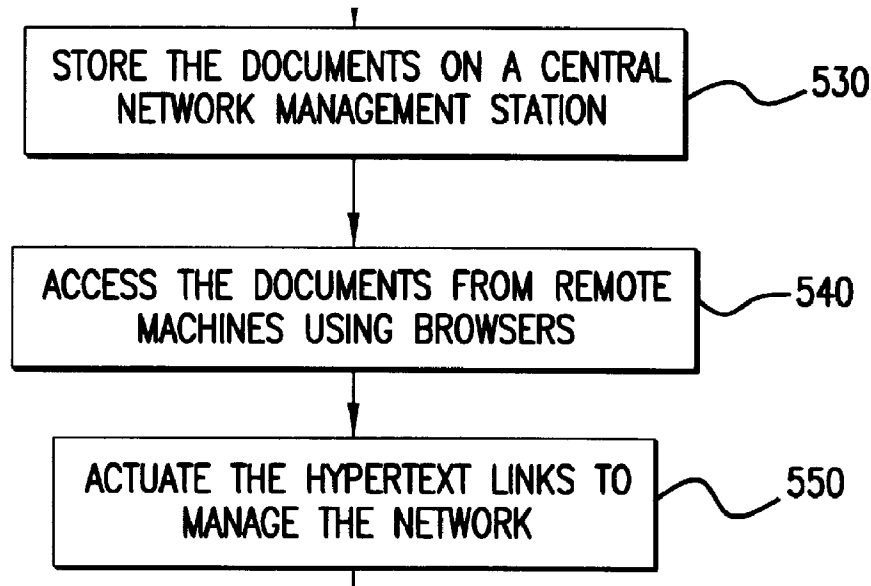
receiving network inventory information, responsive to the indicated scope of network inventory information.

Pages 28-30 of the specification explain a network inventory application environment in which the claimed method may be particularly useful. The limitations of this claim are not found in Prithviraj in view of Lonnroth.

First, claim 25 should be allowable for all of the same reasons as claim 1. The combination of Prithviraj in view of Lonnroth presents at least the same issues here as before. Network scope choices are not locally stored on a palm-sized device in either of the references and cannot be inferred from the combination. Lonnroth’s WML is not readily compatible with Prithviraj’s HTML. The combination is not motivated with admissible evidence.

Moreover, the method depicted in Prithviraj figure 12 and explained in columns 23-24 does not meet the limitation of *indicating a scope of network inventory information*. The Examiner has acquiesced in Applicants’ position that selecting a “node” in Prithviraj means selecting a single network element that has an IP address (col. 24, lines 20-25) and does not meet

the limitation. Shifting positions, in this Office Action the Examiner relies on FIG. 5 reference 550, which is reproduced below:



Actuating the hypertext links cannot reasonably be construed as selecting a scope of network inventory information to be accessed during synchronization. Understanding reference 550 requires studying at least cols. 11-12, FIGS. 7 & 8ABC and cols. 13-14, which explain the documents and hypertext links. FIG. 7 depicts a document with hypertext links. Col. 13-14. The links can be actuated to connect to documents such as those depicted in FIGS. 8A-8C. Col. 14, lines 1-14. Actuating a hypertext link in FIG. 7 would not meet the limitation of *indicating a scope of network inventory information*, unless the semantics of the link corresponded to indicating a scope of network inventory information. Reviewing FIGS. 7 and 8A-8C, it is apparent that these figures do not teach *indicating a scope of network inventory information* by actuating a hypertext link.

For this additional reason, claim 25 should be allowable over Prithviraj in view of Lonnroth.

Claim 49

Claim 49 includes the limitations:

A system for network management using a palm-sized computer, including:
a palm-sized computer running a browser application;
a synchronization server, in communication with the palm-sized computer; and
a network management server, in communication with the synchronization server.

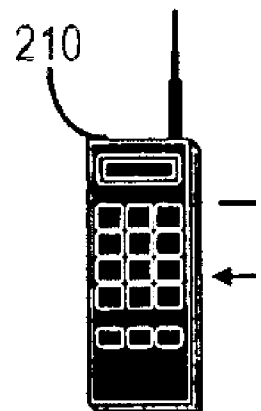
These limitations are not found in Prithviraj in view of Lonnroth.

None of these elements are fully met by Prithviraj. We do not dispute that a browser is depicted, but the Examiner acknowledges that Prithviraj does not teach *a palm-sized computer running a browser application*. Next, as we explained in the context of claim 1, *supra*, Prithviraj ref 560 simply updates data, which is not quite the same as “synchronization.” Prithviraj teaches only updating:



There is no notion in Prithviraj of synchronization; the stem “synchron*” does not even appear in the reference. Conventional meaning is given to a “synch server” throughout the specification of this application, which needs to be given weight when considering patentability. Prithviraj does not teach *a synchronization server, either in communication with the palm-sized computer or in communication with a network management server*. As Prithviraj does not meet any of the elements of claim 49, it does not supply the features for which the Examiner relies on it.

We again challenge the “well-known” statement on page 6, that accessing HTTP servers using palm-sized computers is evident from Lonnroth. MPEP § 2144.03. The Examiner has mistakenly interpreted Lonnroth as accessing an HTTP server (110) using a browser on a palm-sized computer (210). The palm-sized device in Lonnroth is a cell phone depicted with a one or two line display. Reference 210 is illustrated and referred to as a “phone”. The server access by phone 210 is via WAP, which is not the same HTML/HTTP protocol used in Prithviraj. Lonnroth uses an intermediate server to convert XML data using an XSL spreadsheet into wireless markup language (WML) so that the cell phone does not need an HTML browser. The cell phone is not presented as capable of storing a network management page prior to connecting to a synchronization server or as capable of interacting with a synchronization server. As Lonnroth does not add the claimed elements to Prithviraj, neither of the references include claimed elements and neither can the combination.



The passing statement, “Given the teachings of Lonnroth, it would have been obvious to one of skill in the art” <to do what is claimed> does not satisfy the legal standards for combining references, as more fully explained above.

Therefore, claim 49 should be allowable over Prithviraj in view of Lonnroth.

Claims 2, 26 and 50

Claims 2, 26 and 50 share the limitation:

wherein the palm-sized computer is smaller than four inches by six inches

These limitations are not found in Prithviraj in view of Lonnroth.

The Examiner asserts that “the palm-sized computer appears to be smaller than four inches by six inches (Lonnroth, figure 2)”. Immediately above, we reproduced the apparatus that appears in FIG. 2, making it clear that it is a cell phone, not a palm-sized computer. Moreover, given the 1999 filing date and the telescoping antenna, there is no teaching in Lonnroth for the cell phone to be smaller than four inches by six inches.

Therefore, claims 2, 26 and 50 should be allowable over Prithviraj in view of Lonnroth.

Claims 3, 4, 27, 28, 51 and 52

Claims 3, 4, 27, 28, 51 and 52 should be allowable over Prithviraj in view of Lonnroth for at least the same reasons as the claims from which they depend.

Claims 6, 30 and 53-55

Claims 6, 30 and 53-55 should be allowable over Prithviraj in view of Lonnroth for at least the same reasons as the claims from which they depend.

Claims 7, 31 and 56-58

Claims 7, 31 and 56-58 should be allowable over Prithviraj in view of Lonnroth for at least the same reasons as the claims from which they depend.

Claims 8, 32, 59 and 60

Claims 8, 32, 59 and 60 should be allowable over Prithviraj in view of Lonnroth for at least the same reasons as the claims from which they depend.

Claims 9 and 33

Claims 9 and 33 should be allowable over Prithviraj in view of Lonnroth for at least the same reasons as the claims from which they depend.

Claims 10 and 34

Claims 10 and 34 should be allowable over Prithviraj in view of Lonnroth for at least the same reasons as the claims from which they depend.

Claims 11 and 35

Claims 11 and 35 should be allowable over Prithviraj in view of Lonnroth for at least the same reasons as the claims from which they depend.

Claims 14, 38 and 62

Claims 14, 38 and 62 include the limitations:

wherein connecting to the synchronization server includes using a radio signal and a wireless communication server in communication with the synchronization server

These limitations are not found in Prithviraj in view of Lonnroth and further in view of official notice.

The Examiner takes “official notice” that wireless routers eliminate the need for wires.” OA at 7. This does not meet these claim limitations, because the so-called official notice does not extend to using wireless communications to connect a palm sized device to a synchronization server. As of the 2001 priority date of this application, wireless communications were not as prevalent as they are now. There is no reference of record that combines wireless communications with palm sized device synchronization.

Therefore, claims 14, 38 and 62 should be allowable over Prithviraj in view of Lonnroth.

Claims 16 and 40

Claims 16 and 40 should be allowable over Prithviraj in view of Lonnroth for at least the same reasons as the claims from which they depend.

Claims 18 and 42

Claims 18 and 42 should be allowable over Prithviraj in view of Lonnroth for at least the same reasons as the claims from which they depend.

Claims 19-20 and 43-44

Claims 19-20 and 43-44 include the limitations:

wherein the compact markup language utilizes five-bit encoding of characters

wherein the compact markup language utilizes variable length strings for markup tags and characters

These limitations are not found in Prithviraj in view of Lonnroth.

The Examiner relies on Lonnroth FIG. 2. We have examined that figure and the accompanying text in columns 2-10. We did a quick search on WAP that lead to WBXML, a wireless binary XML transmission format and protocol. We did not find either five-bit encoding or variable length strings for markup tags in Lonnroth, either explicitly or implicitly.

Therefore, claims 18-20 and 42-44 should be allowable over Prithviraj in view of Lonnroth.

Claims 21, 22, 45 and 46

Claims 21, 22, 45 and 46 include the limitations:

wherein the page includes a form and data and the updated network management information includes an updated version of some or all of the data

wherein the page includes a form and data and the updated network management information includes an updated version of some or all of the data and does not include the form

We cannot see how Prithviraj figure 5 #560, on which the Examiner relies, meets these limitations, either in the figure or the accompanying text.

Therefore, claims 21, 22, 45 and 46 should be allowable over Prithviraj in view of Lonnroth.

Claims 23 and 47

Claims 23 and 47 should be allowable over Prithviraj in view of Lonnroth for at least the same reasons as the claims from which they depend.

Applicants respectfully submit that claims 1-4, 6-11, 14, 16, 18-23, 25-28, 30-35, 38, 40, 42-47, 49-60 and 62 should be allowable over Prithviraj in view of Lonnroth.

Rejection Under 35 U.S.C. § 103(a) of Claims 5 and 29

The Examiner rejects **claims 5 and 29** under 35 U.S.C. § 103(a) as unpatentable over Prithviraj in view of Lonnroth in further view of Flack (US 6,288,704).

Applicants respectfully submit that claims 5 and 29 should be allowable over Prithviraj in view of Lonnroth in further view of Flack for at least the same reasons as the claims from which they depend.

Rejection Under 35 U.S.C. § 103(a) of Claims 1, 12, 24, 25, 36, 48, 49 and 61

The Examiner rejects **claims 1, 12, 24, 25, 36, 48, 49 and 61** under 35 U.S.C. § 103(a) as unpatentable over Prithviraj in view of Hawkins (US 6,006,274). Effectively, Hawkins is substituted for Lonnroth in this rejection.

Claims 1, 12, 25 and 36

Claims 1, 12, 25 and 36 include limitations such as:

accessing a page containing network management information stored on a palm-sized computer;

indicating a network management function;

connecting to a synchronization server;

transmitting the indicated network management function to the synchronization server; and

receiving updated network management information, responsive to the indicated network management function [and]

wherein connecting to the synchronization server includes placing the palm-sized computer in a communications cradle and pressing a hot sync button

These limitations are not found in Prithviraj in view of Hawkins.

Prithviraj lacks the elements for which the Examiner relies on it for the reasons given on pages 10-14, above. Accordingly, these claims should be allowable.

The Examiner seems to argue that Hawkin's early Palm device, operating in a synchronization mode instead of as a terminal, would readily be substituted by one of ordinary skill for Prithviraj's Network Management System ("NMS") device 101. OA 9-10. We have previously challenged the Examiner's claim that it was well-known in the art to run a browser on a palm sized device and requested compliance with MPEP § 2144.03. *Supra*, at 12. The claim that a palm sized device would be substituted by one of skill in the art for a desktop workstation performing network management monitoring requires substantiation. Hawkin's palm-sized computer did not have the same capabilities as Prithviraj's NMS. *See*, Prithviraj cols. 1-2, 7, 9 *et seq.* It was not continuously connected to the network for monitoring purposes.

The Examiner might alternatively be arguing that writing functional software application running on Hawkin's palm-sized device and synchronized with Prithviraj's NMS would be obvious to one of ordinary skill, without any need for the Examiner to offer evidence. The disclosure in this application bridges the gap between Prithviraj's dedicated workstation and

Hawkin's naked palm-sized platform. Neither of those references disclose, suggest or even hint at how a palm-sized, intermittently connected device might cooperatively interact with a dedicated NMS. The Examiner is not allowed simply to pronounce that bridge to be obvious, without identifying a prior bridge builder.

Therefore, claims 1, 12, 25 and 36 should be allowable over Prithviraj in view of Lonroth in further view of Hawkins.

Claims 49 and 61

Claims 49 and 61 include the limitations:

A system for network management using a palm-sized computer, including:

a palm-sized computer running a browser application;

a synchronization server, in communication with the palm-sized computer; and

*a network management server, in communication with the synchronization server
[and]*

*further including a communications cradle which the palm-sized computer engages
and communicates with, said communications cradle in communication with the
network management server*

These limitations are not found in Prithviraj in view of Hawkins.

Claims 49 and 61 should be allowable over Prithviraj in view of Hawkins for at least the same reasons as claims 1, 12, 25 and 36, discussed above.

Claims 24 and 48

Claims 24 and 48 include the limitations:

*further including transmitting the indicated network function from the
synchronization server to a network management server and transmitting the
updated network information from the network management server to the
synchronization server*

These limitations are not found in Prithviraj in view of Hawkins.

The software applications that would link Prithviraj's NMS through a synchronization server to Hawkin's are not disclosed, suggested or even hinted at by the references. Neither software running on the NMS or on the palm-sized device is suggested.

Therefore, claims 24 and 48 should be allowable over Prithviraj in view of Lonroth in further view of Hawkins.

Applicants respectfully submit that claims 1, 12, 24, 25, 36, 48, 49 and 61 should be allowable over Prithviraj in view of Lonnroth in further view of Hawkins.

Rejection Under 35 U.S.C. § 103(a) of Claims 13, 15, 17, 37, 39, 41 and 63

The Examiner rejects **claims 13, 15, 17, 37 39, 41 and 63** under 35 U.S.C. § 103(a) as unpatentable over Prithviraj in view of Hawkins in further view of Haitani (US 5,900,875) and Hiscock (US 6,721,787).

Claims 13, 15, 17, 37 39, 41 and 63 include the limitations:

wherein pressing the hot sync button starts the synchronization server

wherein a wireless communication server starts the synchronization server when needed

wherein the communication between the palm-sized computer and the synchronization server includes an infrared link

Claims 13, 15, 17, 37 39, 41 and 63 should be allowable over Prithviraj in view of Hawkins in further view of Haitani for at least the same reasons as the claims from which they depend.

CONCLUSION

It is respectfully submitted that this application is now in condition for allowance, and such action is requested. If the Examiner believes a telephone conference would aid the prosecution of this case in any way, please call the undersigned at (650) 712-0340.

The Commissioner is hereby authorized to charge any fee determined to be due in connection with this communication, or credit any overpayment, to our Deposit Account No. 50-0869 (3COM 2487-3).

Respectfully submitted,

Dated: 26 June 2006

/ejb/
Ernest J. Beffel, Jr.
Registration No. 43,489

HAYNES BEFFEL & WOLFELD LLP
P.O. Box 366
Half Moon Bay, CA 94019
Telephone: (650) 712-0340
Facsimile: (650) 712-0263